

PATENT

Atty Docket No.: 200309098-1

App. Scr. No.: 10/693,580

REMARKS

Favorable reconsideration of this application is respectfully requested in view of the forgoing amendments and the following remarks.

Claims 1, 3-7, 9-13, 15-17, 19, and 20 have been amended. Claims 2, 8, and 14 have been canceled without prejudice or disclaimer of the subject matter contained therein. Claims 1, 3-7, 9-13, and 15-20 are currently pending, of which claims 1, 7, 13, and 17 are independent.

Claims 1-6 and 17-20 were rejected under 35 U.S.C. §101 as allegedly being directed to non-statutory subject matter.

Claims 1-2, 4, 7-8, 10, 13-14, and 16 were rejected under 35 U.S.C. §102(e) as allegedly being anticipated by Kraft et al. (6,938,170).

Claims 3, 5-6, 9, 11-12, 15, and 17-20 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Kraft et al. in view of Meyerzon et al. (6,199,081).

The above rejections are respectfully traversed.

Drawings

The Examiner did not indicate whether the Drawings as filed on October 25, 2003 are acceptable. It is assumed that the Drawings are acceptable absent any indication otherwise by the Examiner.

Information Disclosure Statement

The undersigned thanks the Examiner for considering the reference cited in the IDS filed on October 25, 2003.

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Claim Rejection Under 35 U.S.C. §101

The Office Action rejected claims 1-6 and 17-20 as allegedly being directed to non-statutory subject matter. Specifically, the Office Action stated,

Claims 1-6 and 17-20 are rejected under 35 U.S.C. 101 because the method of generating a web page is not limited to a tangible embodiment since the method generating web page requires use of hardware to accomplish generating step [sic]. Therefore, claims 1-6 and 17-21 are non-statutory as not being tangible [sic]. (Emphasis added).

The Examiner already admitted that the method of generating web page inherently *requires the use of hardware* to accomplish the generating step, and, as commonly known and understood, hardware is tangible. It follows that claims 1-6 and 17-20 are directed to tangible subject matter. Therefore, it is not clear why the Examiner considered such claims to not be tangible when the Examiner already provided evidence that they are tangible.

Accordingly, it is respectfully submitted that claims 1-6 and 17-20 satisfy 35 U.S.C. § 101, and withdrawal of the rejection of these claims is respectfully requested.

Claim Rejection under 35 U.S.C. § 102

The test for determining if a reference anticipates a claim, for purposes of a rejection under 35 U.S.C. § 102, is whether the reference discloses all the elements of the claimed combination, or the mechanical equivalents thereof functioning in substantially the same way to produce substantially the same results. As noted by the Court of Appeals for the Federal Circuit in *Lindemann Maschinenfabrick GmbH v. American Hoist and Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984), in evaluating the sufficiency of an anticipation rejection under 35 U.S.C. § 102, the Court stated:

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Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim.

Therefore, if the cited reference does not disclose each and every element of the claimed invention, then the cited reference fails to anticipate the claimed invention and, thus, the claimed invention is distinguishable over the cited reference.

Claims 1-2, 4, 7-8, 10, 13-14, and 16 were rejected under 35 U.S.C. §102(c) as allegedly being anticipated by Kraft et al.

Independent claims 1, 7, 13, and 17 have been amended to include the utilization of "tags to enclose the specific portion so as to designate the specific portion ... without modifying the specific portion." In contrast, as its title indicates, Kraft et al. shows a "system and method for preventing automated crawler access to web-based data sources *using a dynamic data transcoding scheme*," whereby the various transcoding schemes *require actual modification of a specific portion of content*, without any enclosure of such portion by tags, in a web form so as to prevent access to such specific portion. See at least col. 6, lines 32-50; col. 7, lines 25+; and col. 9, lines 55+, as cited by the Office Action.

Accordingly, it is respectfully submitted that amended independent claims 1, 7, 13, and 17 and their dependent claims 3-6, 9-12, 15, 16, and 18-20 are allowable over the references of record. Withdrawal of the rejection of these claims, therefore, is respectfully requested.

Claim Rejection Under 35 U.S.C. §103

The test for determining if a claim is rendered obvious by one or more references for purposes of a rejection under 35 U.S.C. § 103 is set forth in MPEP § 706.02(j):

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To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Therefore, if the above-identified criteria are not met, then the cited reference(s) fails to render obvious the claimed invention and, thus, the claimed invention is distinguishable over the cited reference(s).

Claims 3, 5-6, 9, 11-12, 15, and 17-20 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Kraft et al. in view of Meyerzon et al.

It is respectfully submitted that, for at least the reasons set forth earlier, amended independent claims 1, 7, 13, and 17 are not anticipated by Kraft et al. In addition, the Office Action does not rely upon Meyerzon et al. to make up for the deficiencies in Kraft et al. with respect to claims 1, 7, 13, and 17. Indeed, Meyerzon et al. merely shows an active plug-in that is used to tag an entire web document for exclusion or generally shows that active plug-ins can be used to exclude certain contents from a web document without any details on such an exclusion scheme. See, for example, col. 11, lines 42+, as cited by the Office Action.

Accordingly, claims 3, 5-6, 9, 11-12, 15, and 17-20 are allowable by virtue of their dependency on claims 1, 7, 13, and 17. Withdrawal of the rejection of these claims and their allowance, therefore, are respectfully requested.

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Conclusion

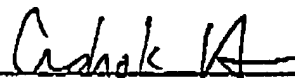
In light of the foregoing, withdrawal of the rejections of record and allowance of this application are earnestly solicited.

Should the Examiner believe that a telephone conference with the undersigned would assist in resolving any issues pertaining to the allowability of the above-identified application, please contact the undersigned at the telephone number listed below. Please grant any required extensions of time and charge any fees due in connection with this request to deposit account no. 08-2025.

Respectfully submitted,

Dated: February 22, 2006

By



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